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DARBY & DARBY P.C. P.O. BOX 770 Church Street Station New York, NY 10008-0770			EXAMINER JOHNSON, VICKY A	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WOLFGANG REIK, CARSTEN BÜNDER,
and ROBERT FISCHER

Appeal 2008-5607
Application 09/982,136
Technology Center 3600

Decided:¹ February 24, 2009

Before WILLIAM F. PATE, III, LINDA E. HORNER, and
KEN B. BARRETT, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Wolfgang Reik et al. (Appellants) seek our review under 35 U.S.C. § 134 from the final rejection of claims 1-5 and 7-16. Claim 6 has been canceled. (App. Br. 2.) We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We REVERSE.

THE INVENTION

Appellants' claimed invention pertains to a vehicle with a clutch that may be actuated automatically. (Spec. 1, ll. 3-6.) Claim 1, reproduced below with paragraphing added, is representative of the subject matter on appeal.

1. A motor vehicle comprising
an engine with an engine block;
a clutch with a clutch-actuator device including at least one element from the group of hydraulic, mechanical and electronic elements, the clutch actuator device including a clutch-release device with at least one clutch-release drive source;
a transmission adjacent to the clutch;
a transmission housing surrounding the transmission;
a clutch bell housing surrounding the clutch;
a control device;
and a carrier element;
wherein the transmission housing is connected to the clutch bell housing and the latter is, in turn, connected to the engine block;

the control device is operable to control at least the clutch in an automated mode;

at least portions of at least one of the clutch-actuator device and the control device are integrated in the carrier element; and

said carrier element is arranged in an intermediate area between the clutch bell housing and the transmission housing.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Machida	US 4,719,812	Jan. 19, 1988
Hardeman	US 5,267,488	Dec. 7, 1993
Burkett	US 5,566,591	Oct. 22, 1996

The following rejections are before us for review:

1. Claims 1-5, 7-8, and 12-16² are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hardeman and Machida; and
2. Claims 9-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hardeman, Machida, and Burkett.

² The statement of the ground of rejection in the Final Rejection identifies claims 1-5, 7-8, and 6-12, but the Examiner's explanation of the bases for the rejection discusses claims 1-5, 7-8, and 12-16. (Final Rej. 2-4.) Appellants understand that claims 13-16 are the subject of this first ground of rejection, even though those claims were not included in the Examiner's statement of the rejection. (App. Br. 8.)

ANALYSIS

The Rejection of Claims 1-5, 7-8, and 12-16 Under 35 U.S.C. § 103(a) as Being Unpatentable Over Hardeman and Machida

Appellants challenge, *inter alia*, the Examiner's reasoning as to why one of ordinary skill in the art would combine the cited references in the claimed manner. (See App. Br. 7.) Appellants incorrectly focus on the space limitation problem that they addressed. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, ___, 127 S. Ct. 1727, 1741-42 (2007) ("neither the particular motivation nor the avowed purpose of the [Appellants] controls" in an obviousness analysis). Nonetheless, we find the Examiner's proffered reasoning underlying the conclusion of obviousness to be deficient in this case.

The Examiner found that Hardeman discloses a carrier element arranged in an intermediate area between the clutch bell housing and the transmission housing. (Final Rej. 2.) The Examiner also found that Hardeman does not disclose a clutch automation device integrated in the carrier element. (*Id.*) The Examiner relied on Machida for the teaching of certain clutch automation devices integrated into a carrier element (Ans. 4), and identified Machida's transmission case cover 29 as that carrier element (Ans. 4; *see also* Machida, col. 3, ll. 38-42 (identifying item 29)). Machida's cover 29 is located on the side of the transmission case, not between the transmission and clutch housings. (See Machida, col. 1, ll. 62-63; Fig. 3.) The Examiner reasoned that:

[I]t would have been obvious to one of ordinary skill in the art in view of the teachings of Machida et al. to include portions of at least one of the clutch actuator device and the control device in the carrier element of Hardeman et al. in order to automate actuation of the clutch.

(Ans. 4.) This reasoning is based on an erroneous interpretation of Hardeman. The Examiner identified Hardeman's item 28 as the clutch bell housing, item 12 as the clutch, and item 10 as the carrier element. (Final Rej. 2.) Claim 1 requires that the clutch bell housing surrounds the clutch. However, Hardeman's item 28 is the torque converter housing (Hardeman, col. 3, ll. 50-51), and item 10 is an adapter housing which houses the clutch 12 (*id.*, col. 3, ll. 29-30, 41-42; Fig. 3). Therefore, Hardeman discloses a transmission housing 46 (*see id.*, col. 3, l. 64) bolted to the clutch housing 10, with no carrier element arranged between the two as recited in Appellants' claim 1. (*See id.*, Fig. 3.)

Because the Examiner has not pointed to a structure in Hardeman that corresponds to the claimed carrier element and because Machida's cover is located on the side of the transmission housing, it is unclear as to why one of ordinary skill in the art would have been led to the claimed arrangement of a carrier element between the clutch bell housing and the transmission housing. Consequently, we are constrained to reverse the rejection of independent claim 1. We also reverse the rejection of claims 2-5, 7-8, and 12-16, which depend directly or indirectly from claim 1.

The Rejection of Claims 9-11 Under 35 U.S.C. § 103(a) as Being Unpatentable Over Hardeman, Machida, and Burkett

Appellants contend that claims 9-11, which depend from claim 1, are patentable over the cited art because Burkett does not cure the deficiencies of the rejection of independent claim 1. (App. Br. 8.) As discussed above, the combination of Hardeman and Machida would not have led one of ordinary skill in the art to a carrier element arranged between the clutch bell housing and the transmission housing. Claims 9-11 pertain to the specifics

of the manufacturing and the material of the carrier element. The Examiner relied on Burkett for teaching these aspects, but has failed to show where Burkett cures the inadequacies of the Hardeman and Machida combination. (*See* Final Rej. 4.) Thus, we do not sustain the rejection of claims 9-11.

CONCLUSIONS

We conclude that the Examiner erred in rejecting claims 1-5, 7-8, and 12-16 under 35 U.S.C. § 103(a) as being unpatentable over Hardeman and Machida, and in rejecting claims 9-11 under 35 U.S.C. § 103(a) as being unpatentable over Hardeman, Machida, and Burkett.

DECISION

The decision of the Examiner to reject claims 1-5 and 7-16 is reversed.

REVERSED

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